

When a patent is drafted in view of the totality of available rules, the skilled patent practitioner will include definitions of key claim terms in the disclosure. In this way, the skilled practitioner can attempt to control or even pre-ordain any future claim construction.

It is only when less than perfect patents fail to define claim terms or when claim terms that are not typically used by those skilled in the relevant art are included in the claims that a court must resort to grasping at straws in an attempt to discern a meaning of claim terms. It is with these less than perfectly drafted patents that grey areas of interpretation are entered. This is referred to herein as the grey zone and grey zone patents. For example, the "definition by implication" rule has been created to resolve such ambiguities. When in the grey zone, skilled minds will arrive at differing claim interpretations regardless of the clarity of rules of interpretation. Clear rules can not rescue a grey zone patent from the sea of uncertainty.

The controlling theme of controversy in patent cases is not the deficiency of available rules available to interpret patent claims, but the deficiencies in the patents themselves. It's not the patent case law that leads to inconsistent interpretation, it's the vagueness in patents themselves. No changes are in patent case law will reduce the amount of litigation caused by grey zone patents.

Should this Court grant certiorari in this case, we submit that it should be only to clarify and reiterate the rules set forth in *Phillips v. AWH*. However, as stated above, when a patent is in the grey zone, even the clearest rules will not yield a universally agreeable claim construction.

II. There is no Intracircuit Split Among Judges of the Federal Circuit

The petitioner attempts to paint a picture of division among the justices of the Federal Circuit Court. However, in *Phillips v. AWH*, 11 of 12 of the judges sitting *en banc* agreed with the claim construction rules stated by the majority. *Phillips*, 415 F.3d 1303. In an opinion which concurs in part and dissents in part, Judge Lourie recognized the harmony of the justices of the Federal Circuit when he stated:

I fully join the portion of the court's opinion resolving the relative weights of specification and dictionaries in interpreting patent claims, in favor of the specification. I could elaborate more expansively on that topic, but Judge Bryson's opinion for the majority says it so well, there is little reason for me to repeat its truths. I also agree with the court that claims need not necessarily be limited to specific or preferred embodiments in the specification, although they are limited to what is contained in the overall disclosure of the specification.

Phillips, 415 F.3d at 1328-1329. Nonetheless, application of the rules can be difficult and cause divergent outcomes. This is seen in the two cases cited by the petitioner in asserting that there is a division of claim interpretation rules used by the Federal Circuit. In arguing that there is a split among judges of the Federal Circuit, the petitioner cites cases that merely exemplify the difficulty in applying patent rules. There is general agreement as to the rules, but there is often disagreement in the application of the rules when the patent at issue is in the grey zone mentioned above.

For example, in *Free Motion v. Cybex*, the dissent merely takes issue with how the applicable patent rule was applied by the majority, not whether an appropriate rule existed for the judges to use to evaluate the claim at issue. *Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343 (Fed. Cir. 2005). The majority in *Free Motion* stated that under *Phillips v. AWH*, when determining the ordinary meaning of a claim term, the claim will *not* presumptively receive its broadest dictionary definition; rather the intrinsic evidence will be scrutinized to determine the most appropriate definition of the claim term. *Id.* at 1348-1349. The *Free Motion* dissent actually agrees with the majority when it accuses the majority of taking "the broadest available abstract meaning of a claim term." *Id.* at 1355. The dissent merely accuses the majority of not following the rule it stated it would apply. Conflicting approaches to patent law do not exist between the majority and dissent in *Free Motion*, merely a difference in factual interpretation is presented.

Similarly, in *Dorel Juvenile v. Graco*, the dissent did not disagree with the claim construction rules used by the majority, but disagreed with the interpretation of the facts of the case using the available claim construction rules. *Dorel Juvenile Group, Inc. v. Graco Children's Prods., Inc.*, 429 F.3d 1043 (Fed. Cir. 2005). In *Dorel Juvenile*, the dissent criticized the majority for failing to properly interpret the claims in the context of the specification. *Id.* at 1050. However, the majority in *Dorel Juvenile* reviewed the specification, found it lacking, and used its skill to interpret the claims according to their view of the specification. *Id.* at 1046 ("The specifications of the patents in suit are mainly directed to the claimed cup holder feature of the inventions, and there is little reference to the concept of the removability of the seat from the base."). As with *Free Motion*, in *Dorel Juvenile* conflicting claim interpretation approaches do not exist between the majority and dissent, but, rather, there is divergent application of available rules driven by the facts of the case.

These two cases exemplify what happens when learned judges analyze facts to interpret a grey zone patent – they arrive at different results.

It is the patentee who can best ordain the outcome of patent claim interpretation of a patent by using definitions in patents. The definitions provide lawyers and judges the tools with which to ascertain the breadth and scope of a claimed invention.

That claim interpretation is a difficult task was recognized by the majority opinion in *Phillips v. AWH*,

[T]here will still remain some cases in which it will be hard to determine whether a person of skill in the art would understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature. While that task may present difficulties in some cases, we nonetheless believe that attempting to resolve that problem in the context of the particular patent is likely to capture the scope of the actual invention more accurately than either strictly limiting the scope of the claims to the embodiments disclosed in the specification or divorcing the claim language from the specification.

Phillips, 415 F.3d at 1323-1324. When patents are drafted clearly, there are sufficient rules to interpret them. When the bounds of a patent are unclear, courts and lawyers can only use the tools at hand to best attempt to obtain an understanding of the patent rights. Although the goal of consistency of patent claim interpretation is one that all can agree on, attempting to create a new rule to achieve this idyllic consistency in the wake of grey zone patents is legal hubris.

CONCLUSION

For the foregoing reasons, we, the Conejo Valley Bar Association, urge the Court to either grant the petition for writ of certiorari to affirm and possibly refine the rules set out in *Philips v. AWH*, or deny the petition for writ of certiorari with an affirmative statement that the rules set out in *Philips v. AWH*, other case law, and the patent laws and rules themselves provide sufficient guidance for claim interpretation.

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